



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,622	01/25/2002	Toshihiro Morita	450101-02902	3915

20999 7590 09/26/2003

FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE- 10TH FL.
NEW YORK, NY 10151

EXAMINER

COBY, FRANTZ

ART UNIT	PAPER NUMBER
----------	--------------

2171

DATE MAILED: 09/26/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/913,622

Applicant(s)

MORITA ET AL.

Examiner

Frantz Coby

Art Unit

2171

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1.
- ☐ Interview Summary (PTO-413) Paper No(s) _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

Art Unit: 2171

This is in response to application filed on January 25, 2002 and preliminary amendment filed on February 15, 2002 in which claims 1-8 are presented for examination.

Status of Claims

Claims 1-8 are pending.

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d) or (f), copies of the certified copies of the priority documents have been received which papers have been placed of record in the file.

Information Disclosure Statement

2. The information disclosure statement filed on August 15, 2001 is in compliance with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609. It has been placed in the application file and the information referred to therein has been considered as to the merits.

Specification

3. The abstract of the disclosure is objected to because it is consisted of a single sentence.

Correction is required. See MPEP § 608.01(b).

4. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions,

Art Unit: 2171

wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

5. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-2, 5 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 2171

8. Claim 1 recites the limitation "the second content" in line 8. There is insufficient antecedent basis for this limitation in the claim.

9. Claim 2 recites the limitation "the usage rule" in line 2. There is insufficient antecedent basis for this limitation in the claim.

10. Claim 5 recites the limitation "the second content" in lines 7-8 and 10-11. There is insufficient antecedent basis for this limitation in the claim.

11. Claim 7 recites the limitation "the second content" in lines 8-10. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the

Art Unit: 2171

reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

13. Claims 1-8 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Weisberg U.S. Patent no. 6,351,736.

As per claim 1, Weisberg et al. disclose an information processor comprising “a first recording means for relating a predetermined number of types of data about a first content as a first data group with the first content and recording the data” (See Weisberg et al. Col. 5, lines 12-41; col.); “a second recording means for relating data of types other than the first main data group about the first content and recording in a sub data group” (See Weisberg et al. Col. 6, lines 10-27). In addition, Weisberg et al. disclose the claimed feature of “the first recording means relating a predetermined number of types of data about the second content as a second main data group with the second content and recording the data, and the second recording means relating data of types other than the second main data group about the second content with the second content and recording the data in the sub data group” (See Weisberg et al. Col. 1, line 65-Col. 2, line 64).

As per claim 2, most of the limitations of this claim have been noted in the rejection of claim 1. Applicant's attention is directed to the rejection of claim 1 above. In addition, Weisberg et al. disclose the claimed feature of “wherein the second recording means records the usage rule for the contents as the other types of data” as an advertisement module for receiving

Art Unit: 2171

advertisement of the second data type and for driving the user computer to display the advertisement (See Weisberg et al. Col. 2, lines 36-41).

As per claim 3, most of the limitations of this claim have been noted in the rejection of claim 1. Applicant's attention is directed to the rejection of claim 1 above. In addition, Weisberg et al. disclose the claimed feature of "wherein the second recording means records, as the other types of data, data used to control a device using the contents" (See Weisberg et al. Col. 1, line 65-Col. 2, line 64).

As per claim 4, most of the limitations of this claim have been noted in the rejection of claim 1. Applicant's attention is directed to the rejection of claim 1 above. In addition, Weisberg et al. disclose the claimed feature of "means for judging, when reading data about a content, whether the type of data to be read is that of data recorded in either the main data group or sub data group" through steps 6-7 of figure 2 wherein a determination is made whether to play the audio file or the advertisement file when the user "clicks" (See Weisberg et al. figure 2, Col. 6, line 59-Col. 7, line 5); and "means for searching for data from a plurality of main data groups of sub data groups based on the result of the search made by the data searching means" as a retrieval means which the user uses to retrieve an audio file or streaming audio data (See Weisberg et al. figure 2, component 4; Col 6, lines 47-58).

As per claims 5-6, all the limitations of these claims have been noted in the rejection of claims 1 and 4. They are therefore rejected as set forth above.

Art Unit: 2171

As per claims 7-8, all the limitations of these claims have been noted in the rejection of claims 1 and 4. They are therefore rejected as set forth above.

Conclusion

Any response to this action should be mailed to:

Commissioner of Patents and trademarks
Washington, D.C. 20231

or faxed to:

(703) 305-9051, (for formal communications
intended for entry)


Or:

(703) 308-5357 (for informal of draft
communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2021 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

I. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantz Coby whose telephone number is (703) 305-4006. The examiner can normally be reached Monday through Friday from 9:00 A.M. to 5:00 P.M.

II. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (703) 308-14367. The Fax phone number for this Group is (703) 746-7238; (703) 746-7239; (703) 746-7240.


FRANTZ COBY
PRIMARY EXAMINER

Technology Center 2171
September 16, 2003